



Attorney's Docket No. 043474/257028

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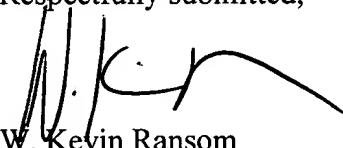
Re: Terrell B. Jones et al.
Appl. No.: 09/141,264
Filed: August 27, 1998
For: GOAL ORIENTED TRAVEL PLANNING SYSTEM

Confirmation No.: 9665
Group Art Unit: 3625
Examiner: Jogesh C. Garg

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REPLY BRIEF TRANSMITTAL
(PATENT APPLICATION – 37 C.F.R. § 1.193(b)(1))

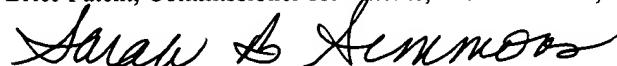
1. Transmitted herewith is the REPLY BRIEF in this application, with respect to the Notice of Appeal filed on May 12, 2004.
2. Applicant claims small entity status.
3. Any fee or refund may be charged to Deposit Account 16-0605.

Respectfully submitted,

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REPLY BRIEF UNDER 37 CFR § 1.193(b)(1)

This Reply Brief is filed pursuant to 37 CFR §1.193(b)(1) and is filed in response to the Examiner's Answer of September 21, 2004, the Examiner's Answer being in response to an Appeal Brief filed July 12, 2004. This Brief addresses a number of points arising from the Appeal Brief, as well as the Examiner's Answer to the same.

11. Response to Argument.

A. Whether Claims 1-57 are properly rejected under 35 U.S.C. § 103(a) based on DeLorme and Official Notice

In rejecting Claims 1-57 of the present application, the Examiner took Official Notice that manually determining "one mode of transportation between the intermediate point and the destination location based upon the travel goal is old and well established in the field of traveling." As support for this proposition, the Examiner explained that a traveler who has to travel to New York from Washington, D.C. would inherently determine which secondary mode of transportation (e.g., taxi, private pick-up, metro, metro bus, walking, rental car, etc.) would suit him based upon the cost and time available to him to reach a destination point in the city at an appointment time.

As stated in the Appeal Brief and as reiterated below, Applicants respectfully submit that the Official Notice was improper. Specifically, Applicants have questioned whether the facts of the Official Notice are capable of instant and unquestionable demonstration as being well known so as to defy dispute as is required by MPEP § 2144.03(A). Further, Applicants submit that the Examiner has not adequately supported the Official Notice with corroborating evidence when requested by Applicants. Finally, Applicants submit that the Examiner has not adequately explained how the facts underlying the Official Notice are combinable with the other cited references.

Provided below are responses to specific issues raised by the Examiner in his Answer. Further, Applicants reiterate reasons why the Examiner's Official Notice is improper.

(i). Response to Specific Issues Raised in Examiner's Answer

In subsection 11.1 of the Examiner's Answer, the Examiner has misinterpreted Applicants' argument concerning the Official Notice issue. In reason (i), the Examiner asserts that Applicants argued that the Official Notice taken by the Examiner fails to show features of the claimed invention. Applicants respectfully submit, however, that Applicants' argument was directed to the fact that the Examiner's Official Notice was improper, not to the application of the Official Notice to the claims. Applicants' argument was and is that the facts underlying the Official Notice are not capable of instant and unquestionable demonstration as being well known so as to defy dispute.

Also, in reason (i) of subsection 11.2 of the Examiner's Answer, the Examiner alleges that the features "including an appointment time for arrival at the destination location," or "determining a secondary mode of transportation from an intermediate point to a destination location, much less based upon the time available to the traveler to reach the destination location by an appointment time," are not the limitations for which the Examiner took Official Notice. Further, in reason (ii) of subsection 11.2, the Examiner appears to allege that Official Notice was only taken with respect to determining mode(s) of transportation between an intermediate point and a destination location based upon a travel goal, somehow independent of the claimed recitation that the travel goal specifies an appointment time for arrival at the destination location.

Applicants respectfully submit, however, that such an interpretation of the Official Notice taken by the Examiner is entirely inconsistent with the interpretation proffered by the Examiner up to that point in the Examiner's Answer.

In the final Official Action, Advisory Action and up to that point in the Examiner's Answer, the Examiner has stated that he took Official Notice of "determining at least one mode of transportation between the intermediate point and the destination location based upon the travel goal." Clearly in this instance the antecedent basis for the phrase "the travel goal" would suggest that the Official Notice was taken of the travel goal in the context of the definition of the travel goal recited earlier in the independent claims of the present application (i.e., a travel goal specifying an appointment time for arrival at the destination location). Somehow, however, the Examiner's characterization of the Official Notice, beginning with reason (ii) of subsection 11.2, now reads "determining at least one mode of transportation between an intermediate point and a destination location based upon a travel goal." Only at this point has the Examiner's characterization referenced "a travel goal," which would less clearly refer back to the earlier recited travel goal.

Finally, in the Answer, the Examiner now alleges that Applicants inadequately traversed the Official Notice and that the Official Notice is taken as admitted prior art in accordance with MPEP § 2144.03. Applicants respectfully submit, however, that Applicants did in fact adequately traverse the Official Action taken by the Examiner, as evidenced by the remarks presented in response to the final Official Action, Appeal Brief, as well as those presented above. In fact, the Examiner has actually attempted to refute Applicants' transversal by citing prior art references to corroborate his Official Notice. It is not clear how the Examiner on one hand can attempt to respond to Applicants' traversal, while on the other hand alleging that Applicants did not adequately traverse the Official Notice.

Moreover, Applicants respectfully submit that the allegation by the Examiner that Applicants did not adequately traverse the Official Notice was not timely lodged. Section 2144.03 of the MPEP, cited by the Examiner for the proposition that failing to traverse the Examiner's Official Notice renders the appropriate facts as admitted prior art, also explicitly states that if Applicants failed to properly traverse the Official Notice, "the examiner should

clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art.” In the instant case, however, the Examiner failed to notify Applicants that Applicants failed to properly traverse the Examiner’s taking of Official Notice, or that the applicable facts were being taken as admitted prior art. In this regard, Applicants traversed the Official Notice in response to the final Official Action of April 12, 2004. In the next Official Action, the Advisory Action of May 10, 2004, the Examiner addressed Applicants’ traversal of the Official Notice by citing the Guenther and Sehr patents as disclosing the facts for which the Examiner took Official Notice, and did not challenge Applicants traversal of the Official Action. To the contrary, as indicated above, the Examiner explicitly cited the Guenther and Sehr patents to “satisfy applicant’s challenge to the Official Notice taken by the examiner in the Final Office action.” Advisory Action, paper 21, page 2. Applicants respectfully submit that this is a clear indication that at the Examiner considered Applicants traversal of the Official Notice as being proper.

(ii). Examiner’s Official Notice Is Improper

As stated in MPEP § 2144.03(A), that when an application is under final rejection, there are only rare circumstances in which “Official notice without documentary evidence to support an examiner’s conclusion is permissible.” Further, the MPEP states that Official Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. Applicants respectfully submit that the Examiner has neither demonstrated that the facts are capable of instant and unquestionable demonstration as being well known nor provided adequate documentary evidence to support his Office Notice. *See id.* (explaining that “[i]t would not be appropriate for an examiner to take official notice of facts without citing prior art reference where the facts asserted to be well known are not capable of instant and questionable demonstration as being well-known).

Moreover, as clearly described in the MPEP, there must typically be some form of evidence in the record to support an assertion of common knowledge. *Id.* at § 2144.03(B) (citing *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)). In this regard, as the Court of Appeals for the

Federal Circuit held in *In re Zurko*, general conclusions regarding what is “basic knowledge” or “common sense” to one of ordinary skill in the art will not support an obviousness rejection without specific factual findings and some concrete evidence in the record to support these findings. 258 F.3d 1379, 1386 (Fed. Cir. 2001). Applicants respectfully submit that in the instant case, the Examiner has failed to meet his burden of providing the requisite concrete evidence to support his findings.

The two pieces of documentary evidence cited by the Examiner, namely the Guenther and Sehr patents, do not corroborate the Official Notice. As explained in the Appeal Brief, while both the Guenther patent and the Sehr patent disclose travel-related systems and methods, neither the Guenther patent nor the Sehr patent supports the Official Notice taken by the Examiner. That is, neither the Guenther patent nor the Sehr patent supports the proposition that it is old and well established that a traveler would inherently determine a secondary mode of transportation based upon the cost and time available to the traveler to reach a destination point in the city at an appointment time. Both the Guenther and Sehr patents disclose systems and methods that are operable for a number of different modes of transportation (e.g., airplanes, railroads, ships, automobiles, subways, buses, rental cards, etc.). Neither patent, however, discloses or suggests determining a mode of transportation from an intermediate point to a destination location based upon the time available to the traveler to reach the destination location by an appointment time, in a manner similar to that recited by independent Claims 1, 20 and 39 of the present invention. In fact, neither patent discloses or suggests determining a mode of transportation from an intermediate point to a destination location, much less based upon the time available to the traveler to reach the destination location by an appointment time.

(iii). The Examiner Failed to Prove that the Official Notice Was Combinable with the Other Cited Prior Art

Applicants further submit that the Examiner failed to indicate a suggestion or motivation for combining the Official Notice with the other cited prior art. As clearly stated § 2143.01 of the MPEP, it is not enough to find elements in individual references. The Examiner must also demonstrate a teaching or suggestion in the references that would motivate one skilled in the art

to combine the references. In the instant case, the Examiner has alleged that the DeLorme patent teaches a number of elements of the claimed invention. For the remaining element of the claimed invention (i.e., “determine at least one mode of transportation between the intermediate point and the destination location based upon the travel goal”), the Examiner has taken Official Notice that it is well known to manually perform this step, and that it would be obvious to merely automate such manual performance. Final Official Action, paper 17, pages 7-8. The Examiner did not, however, allege that one skilled in the art would have been motivated to combine the missing element of the Official Notice with the teachings of the DeLorme patent to teach or suggest the claimed invention nor did the Examiner point to teaching or suggestions in the references that would have motivated one to combine the references. As such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claimed invention.

Thus, for at least the preceding reasons, as well as those presented in the Appeal Brief, Applicants again respectfully submit that the claimed invention of independent Claims 1, 20 and 39, and by dependency Claims 2-19, 21-38 and 40-57, is patentably distinct from the cited references.

B. Whether Claim 58 is properly rejected under 35 U.S.C. § 103(a) based on DeLorme and the Press Release

In subsections 11.3 and 11.4 of the Examiner’s Answer, the Examiner essentially repeated the rejection set forth in the final Official Action concerning the Press Release. As explained in the Appeal Brief, in contrast to independent Claim 58, the Press Release does not teach or suggest recommending a plurality of secondary modes of transportation based on a travel goal to ensure arrival at a destination location by an appointment time. The final Official Action alleges that the Press Release discloses recommending alternative transportation modes to passengers to provide the best information on expected delays and arrival times of buses to enable passengers to calculate transit routes by alternative modes of transportation to their selected destinations. Applicants respectfully submit, however, that the Press Release does not disclose on what basis the travel information service will make its recommendations for alternative modes of transportation, much less based on a travel goal to ensure arrival at a

destination location by an appointment time.

In the Examiner's Answer, the Examiner explains that the travel information service makes its recommendation based upon "expected delays, special events which could affect the arrival time of the transportation carriers to various destination locations, which obviously is the travel goal of the passengers to reach in time at their offices or homes." Examiner's Answer, page 16. If one followed the Examiner's interpretation of the Press Release, however, the travel goal (upon which the recommendations are based in the claimed invention) would illogically correspond to expected delays and special events (upon which the recommendations are based in the Examiner's interpretation of the Press Release). Furthermore, the criteria used by the Press Release are not based on a travel goal of the user. Instead, the criteria is based on expected delays and special events.

Moreover, in the Examiner's Answer, the Examiner alleges that Applicants are improperly relying on the unclaimed feature of "determining the secondary mode of transportation based on a travel goal" to distinguish the claimed invention from the Press Release. Applicants are perplexed by this argument. Claim 58 clearly recites invoking a transportation decision system to select a secondary mode of ground transportation based on the travel goal.

Thus, for at least the reasons presented in the Appeal Brief, Applicants respectfully submit that the claimed invention of independent Claim 58 is patentably distinct from the DeLorme patent and the Press Release, taken individually or in combination.

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Filing Date: August 27, 1998
Page 8

CONCLUSION

For at least the foregoing reasons, as well as those presented in the Appeal Brief,
Applicants respectfully request that the rejections be reversed.

Respectfully submitted,



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